

Section 112 Rejections – Applicant believes that the Section 112 rejection of claims 9 and 13 based on the indefiniteness of the phrase “not less greater than 3.5 inches” has been moot since amendment was requested in the prior Appeal Brief to delete the word “greater”. See the listing of claims in appendix A of the Appeal Brief of August 5, 2005. See also the enclosed Listing of Claims indicating that the word “greater” is no longer in claims 9 and 13. Reconsideration and withdrawal of this rejection is requested.

Section 103(a) Rejections -

(a) Applicant traverses the rejections of claims 1 and 4-13 under Section 103(a) as being unpatentable over Christian in view of Bonnema. Christian teaches simulated logs formed from a foam-filled PCV pipe that the Examiner has stated is “pre-cast with a simulated log design to include knots, cracks and wood grains (e.g. having a diameter deviation).” Applicant submits that this is an incorrect characterization of Christian because a simulated diameter deviation is simply not a real diameter deviation.

Applicant traverses the Examiner’s assertion that a diameter deviation is ornamentation only, serves no mechanical function and thus cannot distinguish over the prior art. Applicant disagrees. The simulated ornamentation on the Christian pipe may be mere ornamentation, but the diameter deviation formed in the extrusion of the plastic log serves to distinguish a “plastic log” from a “plastic pipe”. A natural log has diameter deviation; a plastic log of the invention has diameter deviation. A simulated log does not have diameter deviation and does not suggest a log with diameter deviation. The Examiner’s argument is tantamount to saying that a slice of bread suggests a slab of pasta noodle since both are planar forms of wheat which can be used as a base for softer food, e.g. butter, ground beef, cheese and/or a tomato sauce, and otherwise the shape has no function. With bread the combination functions to provide a hamburger; with the pasta noodle the combination provides a lasagna casserole. Moreover, applicant submits that the Examiner should consider whether, given a choice for fencing his yard with pipe having a simulated wood design or a plastic log with actual diameter deviations, the Examiner would say that they are functionally equivalent because the function of a fence post is mostly to serve as a visual barrier even string would do. If the Examiner were

urged to elect the pipe, applicant submits that the Examiner is likely to say “that won’t work”, i.e. it won’t function as a fence. In short, diameter deviation does serve a function in that it defines a plastic log.

Moreover, the selection of materials is critical to performance and there is no motivation in Bonnema that suggests that polypropylene or polyethylene would provide better performance in a plastic log. There must be some disclosure in Bonnema to a person skilled in the art that polypropylene would be superior to PVC in plastic logs and in such a way to provide a motivation to adapt such a change of materials in a monolithic plastic log that is structurally different from the foam-filled log of Christian. Such disclosure and motivation are missing from Bonnema and Christian and any proposal that they are suggested clearly rests on the impermissible use of hindsight. See *Alza Corporation v. Mylan Laboratories* (Fed Cir, Sept 2006) where the Court of Appeals for the Federal Circuit, a tribunal charged with the judicial supervision of the Patent and Trademark Office, emphasized the requirement for adherence to the *Graham* factors and avoidance of hindsight and resistance to the temptation to read into the prior art the teachings of the invention in issue.

Applicant traverses the Examiner’s suggestion that Christian discloses materials with the same properties as required by the plastic log. Applicant directs the Examiner’s attention to the applicant’s Communication received by the PTO on October 15, 2004 providing evidence that the material properties are significantly different between PVC as used by Christian and polypropylene or polyethylene as used by applicant. There is no indication in the art of record that it would have been obvious to a person of ordinary skill in the art from the disclosure of Christian to make a plastic log with real diameter deviations and substitute the polypropylene or polyethylene for PVD.

(b) Applicant traverses the rejections of claims 1 and 4-13 under Section 103(s) as being unpatentable over Christian in view of Erwin which disclose a method of making the Christian foam-filled PVC pipe, e.g. by injecting a liquid foam into a partially hardened extruded thermoplastic shell. The outer polymer shell is preferably made from polyvinylchloride, but other materials such as acrylic, ABS, polyethylene, polypropylene, polycarbonate, and blends and alloys of two or more of these materials can be used.

Ervin does not suggest that polypropylene and polyethylene will have preferred properties. In fact, Erwin prefers polyvinylchloride, thus providing no motivation to use another polymer exclusively. Moreover Erwin says that "the polymer shell, once hardened, will preferably have a thickness ranging from 0.005 to 0.250 inches" which is far removed from applicants thickness of not less than 3.5 inches with diameter deviations. It is well known that the ultimate mechanical properties of plastics are a function of its dimensions. In this regard there is no motivation by Erwin to make any of the changes to Christian to arrive at the claimed subject greater defined by materials of construction and dimensions.

(c) Applicant traverses the rejections of claims 1 and 4-13 under Section 103(s) as being unpatentable over Erwin. With reference to the above comments summarizes that Erwin does not disclose a plastic log with diameter deviations comprising polypropylene or polyethylene and provides not motivation to a person of ordinary skill in the art to modify the disclosed foam-filled pipe by removing the foam and filling the hollow with the material of the skin. Moreover, Erwin is totally silent on monolithic plastic logs with real diameter deviations. Absent motivation to change Erwin as a matter of law fails to suggest the claimed plastic log. See again *Alza v. Mylan* which emphasizes the requirement for motivation in that art to guard against statutorily proscribed hindsight.

In view of the above comments applicant respectfully submits that there is no legitimate legal basis to support the Section 103 rejections absent hindsight reconstruction. In this regard the Examiner has admitted

"it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper."

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Applicant submits that any hindsight reconstruction is improper. See again *Alza v. Mylan* where the Federal Circuit stated

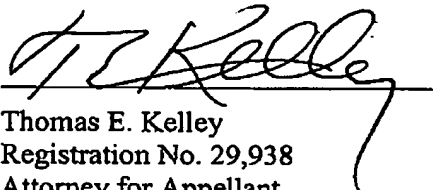
"The Court of Appeals for the Federal Circuit and its predecessor courts 'motivation to combine' requirement likewise prevents the *statutorily proscribed hindsight reasoning* when determining the obviousness of an invention. The 'motivation-suggestion-teaching' requirement protects against the entry of hindsight into the obviousness analysis."

Emphasis by applicant

Applicant believes that the evidence of record failing to show motivation to make the required gross changes from the art to the claimed subject matter and the admission by the Examiner clearly indicate that these Section 103 rejections can be made only on the basis of hindsight and are thus improper. Reconsideration and withdrawal of all of the Section 103 rejections is respectfully requested. Allowance of claims 1 and 4-13 is urgently solicited.

Respectfully submitted,

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